

Remarks

1. Summary of the Office Action

In the office action mailed August 31, 2009, the Examiner withdrew the allowability of claims 14 and 16-21 and newly rejected claims 14, 17-17 and 20-21 under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent No. 6,016,424 (Hicks). In addition, the Examiner objected to claim 19 as being a substantial duplicate of claim 18, and the Examiner objected to claim 18 as being dependent on a rejected base claim but indicated that claim 18 would be allowable if rewritten in independent form.

2. Status of the Claims

Applicant has cancelled claim 19, thus rendering the objection of claim 19 moot. Further, Applicant has rewritten claim 14 in independent form and added new claims

Now pending are claims 14, 16-18, and 20-21, of which claim 14 is independent and the remainder are dependent.

3. Response to the Objection of Claim 18

Applicant has amended claim 18 to be in independent form, incorporating the limitations of the claims from which it depended. Thus, Applicant understands that claim 18 is now allowable as indicated by the Examiner. Applicant has also added new claims 32 and 33 depending from allowable claim 18, to recite the same features that are recited by dependent claims 16 and 21. Applicant submits that new claims 32 and 33 are allowable for at least the reason that they depend from allowable claim 18.

4. Response to Claim Rejections

As noted above, the Examiner rejected independent claim 14 as being allegedly anticipated by Hicks.

Applicant submits that this rejection is clearly erroneous and should be withdrawn, because Hicks does not disclose the combination of elements recited by claim 14 as would be required to establish anticipation under M.P.E.P. § 2131. At a minimum, for instance, Hicks fails to disclose the feature of "creating the electronic message only after determining that the expected delay is less than the threshold delay."

According to Hicks, a mobile station will receive a delay parameter from a base station, indicating how long the mobile station will need to wait before the mobile station transmits a "teleservice transaction," and the mobile station will then set a timer that must expire before the mobile station transmits a "teleservice transaction." Although Hicks seems to use obscure terminology (e.g., transmitting a teleservice transaction), it is clear from the disclosure of Hicks that what Hicks means is sending an SMS message. According to Hicks, after a user has created an SMS message on the mobile station, the mobile station may determine if the delay timer is running and, if so, the mobile station may then hold the user's SMS message until the timer expires, at which point the mobile station may automatically send the SMS message. (*See, e.g.*, Hicks at column 2, line 60 – column 3, line 16)

With the process described by Hicks, the SMS message is thus already created by the time a determination is made as to whether the delay is zero (i.e., whether the delay is less than an example threshold). (*Id.* (including a disclosure of letting the user know that the user's message cannot be sent, which suggests that the message has already been created but has just not yet been sent.)) Consequently, Hicks does not teach at least the claim feature of "creating the electronic message only after determining that the expected delay is less than the threshold delay."

In rejecting claim 14, the Examiner asserted that Hicks teaches the feature of "creating the electronic message only after determining that the expected delay is less than the threshold delay" at column 3, line 60 – column 4, line 5, where Hicks teaches that if a new teleservice transaction is to be sent a new message is created and replaces the messages in the queue. But this teaching of Hicks clearly does not amount to the claim feature at issue. Rather, what Hicks teaches at the cited portion is merely the idea that the user wishes to send a new SMS message at a time when old SMS message is already queued due to the delay time not yet being expired. According to Hicks, the user in that scenario would be given an option of whether transmit the new SMS message instead of the old SMS message when the delay time expires. And Hicks explains that, if the user opts to have the new SMS message transmitted in place of the old SMS message, the new SMS message is substituted in memory for the old teleservice message. None of this process amounts to "creating the electronic message only after determining that the expected delay is less than the threshold delay," however.

Because Hicks does not teach the combination of elements recited by claim 14, Hicks does not anticipate claim 14. Therefore, Applicant submits that claim 14 is allowable. Further, Applicant submits that claims 16-17 and 20-21 are allowable as well for at least the reason that they depend from allowable claim 14.

5. Conclusion

For the foregoing reasons, and without conceding any assertion by the Examiner that is not expressly addressed by these remarks, Applicant submits that all of the claims are allowable. Therefore, Applicant respectfully requests favorable reconsideration and allowance of the claims.

If the Examiner would like to discuss this case with the undersigned, the Examiner is invited to call the undersigned at (312) 913-2141.

Respectfully submitted,

**McDONNELL BOEHNEN
HULBERT & BERGHOFF LLP**

Date: November 24, 2009

By: Lawrence H. Aaronson/

Lawrence H. Aaronson
Reg. No. 35,818